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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,557	08/18/2000	Brydon L. Bennett	860098.436	6892

7590

07/09/2004

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NEW YORK, NY 10036-2711

EXAMINER
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STOCKTON, LAURA

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/642,557

Applicant(s)

BENNETT ET AL.

Examiner

Laura L. Stockton, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8, 24-38 and 40-54 is/are pending in the application.
- 4a) Of the above claim(s) 28-33 and 40-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8, 24-27, 36, 37, 50, 52 and 54 is/are rejected.
- 7) ☒ Claim(s) 4-7, 34, 35, 38, 47-49, 51 and 53 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

Claims 1-8, 24-38 and 40-54 are pending in the application.

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 13, 2004 has been entered.

Rejections made in the previous Office Action that do not appear below have been overcome. Therefore, arguments pertaining to these rejections will not be addressed. However, the following now applies.

*Election/Restrictions*

Restriction to one of the following inventions is required under 35

U.S.C. 121:

- I. Claims 1-8, 24-27, 34-38 and 47-54, drawn to products, classified in class 548, subclasses 356.5 and 357.1.
- II. Claims 28-33 and 40-46, drawn to methods of use, classified in class 514, subclass 403.

The inventions are distinct, each from the other because of the following reasons: Inventions of Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different product.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Michael Bruner on July 6, 2004, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8, 24-27, 34-38 and 47-54. Affirmation of this election must be made by applicant in replying to this Office action. Claims 28-33 and 40-46 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application.

Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in

accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction

requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C.

112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 36 and 37 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for diseases or disorders such as rheumatoid arthritis, asthma, hepatitis, does not reasonably provide enablement for all the diseases or disorders listed in claim 36 such as all cancers. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.



In In re Wands, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. § 112, first paragraph, have been described. They are:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

In the instant case, Applicants are claiming a composition for treating a multitude of diseases and disorders such as all cancers. The nature of the pharmaceutical arts is that it involves screening in vitro and in vivo to determine which compounds exhibit the desired pharmacological activities. There is no absolute predictability even in

view of the seemingly high level of skill in the art. The cancer therapy art remains highly unpredictable. The various types of cancers have different causative agents, involve different cellular mechanisms, and, consequently, differ in treatment protocol. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any therapeutic regimen on its face. Therefore, based on the unpredictable nature of the invention and the state of the prior art, one skilled in the art could not use the claimed invention without undue experimentation.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 8, 24, 25 and 50 are rejected under 35 U.S.C. 102(b)  
as being anticipated by:

- a) Laakso et al. {CA 51:76969, 1957} – see the compound of  
CA Registry No. 130831-58-2;
- b) Mosby et al. {CA 54:80551, 1960} – see the compound of  
CA Registry No. 108799-20-8;
- c) Akamatsu {CA 58:27252, 1963} – see, for example, the  
compound of CA Registry No. 97864-24-9;
- d) Tzikas {U.S. Pat. 4,202,827} – see the compound of Example  
12 in water (column 4);
- e) Farbwerke Hoechst A. -G. {GB 1,293,557} – see 5- or 8-  
amino-1,9-pyrazolanthrone, page 8, line 2; or
- f) Neeff {DE 1257149} – see 5- or 8-amino-1,9-  
pyrazolanthrone (column 4, lines 1-2).

Each of the above cited prior art disclose at least one compound  
embraced by the instant claimed invention.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 26, 27, 52 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tzikas {U.S. Pat. 4,198,518} and Showalter et al. {U.S. Pat. 4,556,654}, each taken alone.

*Determination of the scope and content of the prior art (MPEP §2141.01)*

Applicants claim pyrazoloanthrone compounds. Tzikas (column 1, lines 5-40; and especially Example 7 in column 3) and Showalter et al. (column 1; column 21, lines 38-62; column 35, lines 64-68; columns 39-42; and especially the 1<sup>st</sup>, 6<sup>th</sup> and 8<sup>th</sup> compounds in columns 25-26) each teach pyrazoloanthrone compounds that are structurally similar to the instant claimed compounds.

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

The difference between the compounds of the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in the prior art.

*Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)*

The indiscriminate selection of “some” among “many” is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., an anti-tumor agent).

One skilled in the art would thus be motivated to prepare compounds embraced by the prior art to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial compounds which would be useful in treating tumors. The instant claimed invention would have been suggested to one skilled in the art

and therefore, the instant claimed invention would have been obvious to one skilled in the art.

*Allowable Subject Matter*

Claims 4-7, 34, 35, 38, 47-49, 51 and 53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

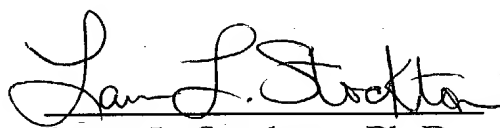
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

A handwritten signature in cursive script, reading "Laura L. Stockton". The signature is written in dark ink and is positioned above the printed name.

Laura L. Stockton, Ph.D.  
Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600

July 8, 2004